

**REMARKS**

Claims 1-52 have been examined. With this amendment, Applicant adds claims 53 and 54. Claims 1-54 are all the claims pending in the application.

**1. Formalities**

The Examiner still has not initialed Japanese Document 7-37074 reference listed in the Information Disclosure Statement filed on March 27, 2001. Applicant respectfully requests that the Examiner consider the reference and return an initialed form PTO-1449.

**2. Claim Rejections Under 35 U.S.C. § 103**

**A. Claims 1, 7, 13, 22, 23, 26, 32, 38 and 47-52**

The Examiner has rejected claims 1, 7, 13, 22, 23, 26, 32, 38 and 47-52 under 35 U.S.C. § 103(a) as being unpatentable over Some et al. (US 5,841,148) [“Some”] in view of Branson [“Branson”]. For at least the following reasons, Applicant traverses the rejection.

The Examiner concedes that Some does not disclose the “arranging, or switching in sequence, and displaying two or more inter-image-processed images” as claimed in independent claims 1. The Examiner attempts to cure this deficiency by applying Branson.

Branson relates to controlling the acquisition, processing, storage, and display of endoscope images based on user preferences (col. 1, lines 12-38). The Examiner alleges that it would have been obvious for one skilled in the art to combine the teaching of Some with Branson in order to incorporate the zooming and interlaced video function of Branson with Some.

Applicant submits that one skilled in the art would not combine the references as suggested by the Examiner because the teachings of Branson are not needed or would be contrary to the objectives of Some. For example, Some already discloses an enlarging/reducing section to magnify the image (see col. 11, lines 5-25). Therefore, the teachings of Branson with respect to the zooming function are not needed.

With respect to the interlaced video function, Applicant submits that the teachings of Branson are not needed and even if they could be implemented, the objectives of Some would be undermined. Branson discloses a method to reduce noise due to motion on an interlaced video display.

Some discloses the use of still images from sources such as stimuable phosphor detecting system (see generally Description of Prior Art). Therefore, there is no motion to create interlace noise and effect the display.

Even if, for the sake of argument alone, Some was modified to display video images, the objectives of Some would be undermined. The objectives of Some are to accurately and quickly correct deviations in positions between two images (col. 3, lines 59-64). To accomplish this objective, an operator must manually specify two corresponding pairs of points in the images so that calculation time can be reduced (col. 15, lines 14-18). The video system of Branson would produce a plurality of images every second. It would be very time consuming, if not impossible, for an operator to manually select corresponding points on every image. Therefore, one skilled in the art would not have combined the references as suggested by the Examiner.

In addition, there is no disclosure in Some or Branson that the original images constitute “each of two or more pairs of original images selected from three or more original images” as set forth in claim 1. Applicant submits that this feature is not inherent in Some as the Examiner seems to imply since it’s possible that subsequent comparisons can be done with the processed image rather than the original.

Further, Some relates to accurately and/or precisely matching two images with each other. That is, an image processing where two images are to be matched with each other using a superposing process or a subtraction process in which one of the images is rotated, enlarged or reduced in size in order to be precisely matched with the other image. Some carries out this process precisely by conducting template matching and affine conversion. The Examiner has not explained the relevance between the image matching taught by Some and the claimed comparison by providing the specificity required to support a *prima facie* case of obviousness.

The second reference, Branson, relates to showing an image viewed through an endoscope, which changes by the minute, in various modes. Therefore, there is no teaching in Branson or Some of “displaying two or more interimage-processed images” of the same subject in such a manner that “they become objects of comparison and reading” (i.e., where the differences between the two images are easy to recognize).

Applicant also submits that the combination of Some and Branson would not create anything useful since the inventions are fundamentally different and the Examiner has not provided an explanation as why one skilled in the art would combine these unrelated references.

Accordingly, Applicant submits that it would have been impossible for anyone skilled in the art to combine the teachings of the cited art. Any such contention can only be made with the use of impermissible hindsight and the aid of Applicant's disclosure.

With respect to independent claim 26, the Examiner concedes that Some does not disclose the display-format setting means as set forth in claim 26, but applies Branson to allegedly cure the deficiency. The Examiner's proffered reason to combine is the same as that give above; therefore, Applicant submits the Examiner's position is not supported for at least the reasons stated above.

In addition, Some discloses that, beyond the selection of images for processing, an operator is required to start the actual inter-image processing by selecting two pairs of corresponding points within the images themselves (col. 15, 33-38), therefore, the Examiner's contention that Some discloses the interimage processing as set forth in claim 26 is not supported. Method steps such as those performed by an operator do not establish the presence of elemental steps of claims for an apparatus. *See In Re Bell*, 26 USPQ2d 1529 (Fed. Cir. 1993).

Because claims 7, 13, 22, 23, 32, 38 and 47-52 depend on either independent claim 1 or 26, Applicant submits that these claims are patentable at least by virtue of their respective dependencies.

#### **B. Claims 11 and 36**

The Examiner has rejected claims 11 and 36 under 35 U.S.C. § 103(a) as being unpatentable over Some in view of Branson and Ishihara et al. (US 5,241,473) ["Ishihara"].

Because claims 11 and 36 depend on claims 1 and 26, respectively, and because Ishihara does not cure the deficient teachings of Some and Branson with respect to claims 1 and 26, Applicant submits that claims 11 and 36 are patentable at least by virtue of their respective dependencies.

**C. Claims 2-6, 8-10, 12, 14-21, 24, 25, 27-31, 33-35, 37 and 39-46**

The Examiner has rejected claims 2-6, 8-10, 12, 14-21, 24, 25, 27-31, 33-35, 37 and 39-46 under 35 U.S.C. § 103(a) as being unpatentable over Some in view of Branson and Gupta et al. (US 6,292,683) [“Gupta”].

Because these claims depend on either claim 1 or claim 26, and because Gupta does not cure the deficient teachings of Some or Branson with respect to claims 1 and 26, Applicant submits that these claims are patentable at least by virtue of their respective dependencies.

**3. New Claims**

With this amendment, Applicant adds claims 53 and 54. Applicant submits that these claims are patentable at least by virtue of their respective dependencies, as well as the features set forth therein.

**4. Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

AMENDMENT UNDER 37 C.F.R. § 1.111  
Application No.: 09/748,384

Attorney Docket No.: Q61247

Pursuant to 37 C.F.R. § 1.136, Applicant is filing a petition (with fee) for three months of extension time herewith, making this response due on or before August 25, 2004. The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

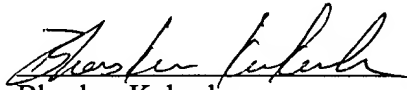
Respectfully submitted,

SUGHRUE MION, PLLC  
Telephone: (202) 293-7060  
Facsimile: (202) 293-7860

WASHINGTON OFFICE

**23373**

CUSTOMER NUMBER

  
Bhaskar Kakarla  
Registration No. 54,627

Date: August 24, 2004